

REMARKS

Applicants thank the Examiner for the thorough consideration given the present application.

Claims 32-57 are now present in this application. Claims 32, 45 and 54 are independent. Claims 38, 42, 43, 45, 47 and 49-51 have been withdrawn from consideration as being directed to a non-elected invention.

Reconsideration of this application is respectfully requested.

I. Withdrawal of Premature Final Rejection

The Examiner has made the outstanding Office Action final, alleging that Applicants' amendment necessitated the new ground of rejection in the Office Action.

Applicants respectfully disagree.

In the first place, the only claim amendments that were made in the Amendment filed on May 3, 2004 were to overcome the rejection of claims 46, 48, 56 and 57 under 35 U.S.C. §112, second paragraph. In fact, those amendments have resulted in a withdrawal of that rejection under 35 U.S.C. §112, second paragraph. Applicants' amendment of claims 46, 48, 56 and 57 has nothing to do with the merits of claim 41, which is the claim that is being rejected for the first time on its merits, and which has not been amended on its merits based on the previous rejection.

In the second place, this Office Action constitutes the first Office Action on the merits of previously withdrawn claim 41 and cannot properly be made a final rejection because Applicants are entitled to traverse this first rejection of claim 41 on its merits under 37 C.F.R. §1.111 and have all of their reasons for traversal treated on their merits in a subsequent Office Action.

Accordingly, withdrawal of the finality of this rejection is respectfully requested.

II. Rejections under 35 U.S.C. §103

Claims 32-37, 39-41, 44, 46 and 52-56 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 11-060117A in view of JP 4-50297 Y2. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the

pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933. The Examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc., 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987) and In re Kamm, 452 F.2d 1052, 1057, 172 USPQ 298, 301-2 (CCPA 1972), and obviousness cannot be established by locating references which describe various aspects of Applicants' invention without also providing evidence of the motivating force which would impel one skilled in the art to do what Applicants have done. Ex parte Levengood, 28 USPQ2d 1300, 1302 (Bd. App. & Int. 1993). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness.

These showings must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

The Office Action admits that JP 11-060117A, the primary reference in the rejection, does not disclose the claimed feature that the installation member is fixed on the upper portion of the counterweight guide rails.

In an attempt to remedy this deficiency, the Office Action turns to JP '297, which discloses an elevator with a traction sheave attached to the upper part of one or more counter weight guide rails 10, 11 and 11a.

The Office Action states that in JP '297, "having the installation member fixed on the counterweight guide rails would allow the load in the vertical direction applied to the winding apparatus is absorbed by the guide rail thus cost for the building materials can be reduced."

The Office Action then concludes that it would be obvious to "have fixed the installation member of JP '117 on the upper portion of the guide rails in order to reduce the cost for the building material as taught by JP '297."

There are several reasons why this rejection fails to make out a *prima facie* case of obviousness of the claimed invention.

In the first place, as is well settled, a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection he or she advances. An Examiner may not, because he or she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis, See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Although the Office Action indicates where JP '297 teaches that fixing an installation member on the counterweight guide rails would allow reduced building materials cost, no evidence is presented of the cost of materials involved in either of the two applied references. Moreover, Applicants respectfully submit that the statement about costs in JP '297 is stated with respect to the prior art disclosed in JP '297, which includes either (1) a separate mechanical chamber installed above the elevator or (2) a separate mechanical chamber installed adjacent to the lower side of the elevator shaft – see pages 1 and 2 of JP '297.

While eliminating either type of separate mechanical chamber will result in cost savings, JP '117, the base reference being applied in this rejection, does not disclose a separate mechanical chamber. Accordingly, the alleged “cost savings” feature of JP '247 is not relevant to any modification of JP '117. Furthermore, the Office Action has not provided objective factual evidence to support a conclusion that fixing an installation member on counterweight guide rails would result in cost savings compared to the structure of JP '117, wherein hoist 9 and sheave 8 do not require a separate mechanical chamber.

Applicants respectfully submit that there would be no obvious cost savings because neither JP '117 nor JP '247 involve use of a separate mechanical chamber. To suggest that there would be significant enough cost savings to motivate a skilled worker to redesign JP '117 is speculation not supported by objective factual evidence commensurate with such a speculative assertion.

In the second place, there appears to be another persuasive reason why one of ordinary skill in the art would have a disincentive to modify JP '117 in view of JP '297. The counterweight guide rails 11 of JP '117 are separate and apart from the elevator guide rails 10 and do not extend above the elevator, so that if JP '117 were to be modified as suggested in the Office Action, i.e., to be placed on the upper portion of JP '117 counterweight guide rails 11, the elevator would not work properly. Reference is made in this regard to Fig. 4, which shows two separate platforms 13 and 13a for two separate hoists, the platform 13a being located well below the elevator.

If JP '117 is modified as suggested, Applicants do not understand how it will result in an elevator that will rise to the upper floor.

The Office Action fails to demonstrate that making the proposed modification of JP '117 would result in a properly working elevator, especially in view of the aforementioned differences between the two applied references.

Moreover, even if the alleged motivation is nothing more than a broad, general statement about costs of materials which does not constitute specific objective evidence which would properly motivate, i.e., give one of ordinary skill in the art the desire to modify JP '117, which apparently has no need to be modified to achieve its stated goal of eliminating a machine room, to achieve the claimed invention. See, in this regard, Dembiczak, cited above.

Additionally, the Office Action also fails to point out other differences

between these two references as required by Graham v. John Deere, cited above. Applicants note that there are other significant differences between these two applied references than the aforementioned counterweight guide rail differences.

As noted in the rejection, JP '117 discloses a 2-to-3 roping ratio. The Office Action is silent, however, in the roping ratio of JP '297, which appears to be 2-to-4. The Office Action does not explain what roping ratio the resultant reference combination would have and whether leaving it the same in the resultant reference combination would work at all, or efficiently, or whether having to change the roping combination of JP '117 from 2-to-3 to 2-to-4 (as disclosed in JP '247) would offer enough of a disincentive to even making the proposed modification of JP '117.

This is a real-world difference that has to be taken into consideration by one of ordinary skill in the art in deciding whether to modify one elevator system with one type of roping ratio in view of an elevator system with a different type or roping ratio, and the burden is on the office to demonstrate why this factor should not be taken into account and why the proposed modification would result in an properly working device. Applicants respectfully submit that the Office has not met its burden in this regard by stating that the Examiner is "merely rely[ing] on the teaching of having the

installing member fixed on the upper portion of the counterweight guide rails.
Not the roping of JP '297."

The Examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve Inc., 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987) and In re Kamm, 452 F.2d 1052, 1057, 172 USPQ 298, 301-2 (CCPA 1972), and obviousness cannot be established by locating references which describe various aspects of Applicants' invention without also providing evidence of the motivating force which would impel one skilled in the art to do what Applicants have done. Ex parte Levengood, 28 USPQ2d 1300, 1302 (Bd. App. & Int. 1993).

Here the Office Action improperly ignores significant differences between JP '117 and JP '297 in making this rejection and, thereby does not make a proper rejection under 35 U.S.C. §103(a).

A fair, balanced appraisal of the rejection reveals that it (1) is improperly based on a cost savings theory that has not been demonstrated by the Office Action to apply to the main applied reference, (2) fails to address the significant differences between the references which Applicants point out would teach away from making the proposed modification of JP '117 in view of JP '247; (3)

improperly picks and chooses parts of each reference to apply in the rejection while ignoring other disclosed parts of the applied references; and (4) would result in an elevator that would not work properly.

Accordingly, Applicants respectfully submit that this rejection is improper and should be withdrawn.

Reconsideration and allowance of claims 32-37, 39-41, 44, 46 and 52-56 are respectfully requested.

III. Allowable Subject Matter

The Examiner states that claims 48 and 57 would be allowable if rewritten in independent form.

Applicants thank the Examiner for the early indication of allowable subject matter in this application. However, claims 48 and 57 have not been rewritten in independent form at this time, since it is believed that independent claim 32 from which these claims depend is allowable for reasons stated, *infra*.

IV. Additional Cited References

Because the remaining references of record have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

V. Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8076, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

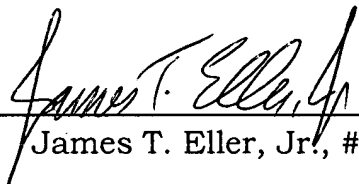
Application No.: 09/474,121
Reply to February 25, 2005 Office Action


Docket No. 0630-1029P

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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0630-1029P

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